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EXAMINER

HARPER, KEVIN C

ART UNIT

PAPER NUMBER

2666

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/036,861

Applicant(s)

GORMAN ET AL.

Examiner

Kevin C. Harper

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 48-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 48-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>04/02, 02/05</u> | 6) <input type="checkbox"/> Other: _____ |

Priority

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

1. An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence(s) of the specification or in an application data sheet (www.uspto.gov/web/offices/pac/dapp/sir/doc/patappde.html) by identifying the prior application by application number (37 CFR 1.78(a)(2) and (a)(5)). If the prior application is a non-provisional application, the specific reference must also include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

Claim Objections

2. Claim 52 is objected to because in line 2-3, only the subscriber interface in combination with the analog telephone is capable of monitoring and accessing the derived digital telephone lines (specification, page 19, lines 17-28; page 20, lines 2-6; page 24, lines 24-31; fig. 10)
 3. Claim 52 is objected to because in line 3, "lines is" should be --lines and is--.
- Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

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Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 48-54, 56, 59-61 and 63 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,370,149 in view of Whittaker et al. (US, 6130,893).

4. Regarding claims 48, claim 1 of the '149 patent recites all the claimed limitations except a plurality of derived digital telephone lines. Whittaker discloses derived digital telephone lines (col. 1, lines 28-37). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to recite a plurality of derived digital telephone lines in the '149 patent in order to allow the use of several analog telephones over a DSL connection (Whittaker, col. 3, lines 31-35).

5. Further, claim 1 of the '149 patent additionally recites that the analog telephone in combination with the subscriber interface is capable of accessing and monitoring the plurality of derived digital telephone lines. In removing functionality, the scope of the claim is merely broadened. It has been held that omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA). Also note *Ex parte Rainu*, 168 USPQ 365 (Bd. App. 1969) (omission of a reference element whose function is not needed would be obvious to one skilled in the art). Therefore, it

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would have been obvious to one skilled in the art at the time the invention was made to remove the additional functionality of the subscriber interface.

6. Regarding claim 49, claim 2 of the '149 patent recites the claimed limitations.
7. Regarding claim 50, claim 3 of the '149 patent recites the claimed limitations.
8. Regarding claim 51, claim 4 of the '149 patent recites the claimed limitations.
9. Regarding claim 52, claim 1(last paragraph) of the '149 patent recites the claimed limitations.
10. Regarding claim 53, claim 5 of the '149 patent recites the claimed limitations.
11. Regarding claim 54, claim 1 of the '149 patent recites a subscriber interface unit for monitoring derived digital phone channels. However, claim 1 does not recite the subscriber interface determining a first digital telephone line is in use based on the content of data packets and generating a line-in-use signal indicating that the derived digital telephone line is in use. Whittaker discloses monitoring at the subscriber interface the content of at least one data packet and determining if the derived digital telephone line is in use based on the content of the data packet (col. 4, lines 43-48) and generating a line-in-use signal (col. 4, lines 50-54; note: ring signal). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to recite monitoring data packets and generating a line-in-use signal in the '149 patent to determine when an incoming call in a packet system is present.
12. Further, claim 1 of the '149 patent additionally recites a housing, an electrical coupler, and an RJ-11 jack. In removing these items, the scope is merely broadened by eliminating elements and their functions from the claims. It has been held that omission of an element and its function is an obvious expedient if the remaining elements perform the same function as

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before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex parte Rainu, 168 USPQ 365 (Bd. App. 1969) (omission of a reference element whose function is not needed would be obvious to one skilled in the art). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to remove the additional functionality of the subscriber interface.

13. Regarding claim 56, claim 1, of the '149 patent does not recite an add-a line signal.

Whittaker discloses receiving an add-a-line signal generated by the subscriber interface (col. 5, lines 8-10) in response to an action of a user (col. 5, lines 2-8) and initiating a second derived digital telephone line in response to the add-a-line signal (col. 5, lines 12-14). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to recite an add-a-line signal in the '149 patent to make available more than one call at the end user location (Whittaker, fig. 1, items 30a and 30b).

14. Regarding claim 59, claim 5 of the '149 patent recites the claimed limitations.

15. Regarding claims 60-61, claim 1 of the '149 patent recites a subscriber interface unit for monitoring derived digital phone channels. However, claim 1 does not recite receiving an off-hook signal generated by the subscriber interface and initiating a first derived digital telephone line in response to the off-hook signal and a line-in-use signal. Whittaker discloses receiving an off-hook signal (col. 5, lines 7-8) generated by the subscriber interface in response to a user action (col. 5, lines 3-8) and initiating a first derived digital telephone line in response to the off-hook signal (col. 5, lines 9-14). A line-in-use signal is generated by the subscriber interface and indicates that a first derived digital telephone line is in use (col. 5, lines 5-8). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to recite

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generating an off-hook signal in the '149 patent in order to send outgoing data packets converted for an analog telephone connected to the subscriber unit.

16. Further, claim 1 of the '149 patent additionally recites a housing, an electrical coupler, and an RJ-11 jack. In removing these items, the scope is merely broadened by eliminating elements and their functions from the claims. It has been held that omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex parte Rainu, 168 USPQ 365 (Bd. App. 1969) (omission of a reference element whose function is not needed would be obvious to one skilled in the art). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to remove the additional functionality of the subscriber interface.

17. Regarding claim 63, claim 1, of the '149 patent does not disclose monitoring data packets at the subscriber interface. Whittaker discloses monitoring at the subscriber interface the content of at least one data packet and determining if the derived digital telephone line is in use based on the content of the data packet (col. 4, lines 43-48). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to recite monitoring data packets and generating a line-in-use signal in the '149 patent to determine when an incoming call in a packet system is present.

Claims 55 and 62 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,370,149 in view of Whittaker et al. (US 6,130,893), in further view of Grabowy (US 4,588,862).

18. Claims 55 and 62 are rejected to include Grabowy in the combination for the reasons indicated in the 35 USC 103 rejection below.

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Claims 57-58 and 64 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,370,149 in view of Whittaker et al. (US 6,130,893), in further view of Fraser (US 5,926,464).

19. Claims 57-58 and 64 are rejected to include Fraser in the combination for the reasons indicated in the 35 USC 103 rejection below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 54, 56, 59-61 and 63 are rejected under 35 U.S.C. 102(e) as being anticipated by Whittaker et al. (US 6,130,893).

20. Regarding claim 54, Whittaker discloses a method for use in a telecommunication system (fig. 1, item 16; fig. 2; col. 3, lines 17-25) including a digital switch (fig. 2, item 92), a local loop (fig. 1, item 12) coupling the digital switch to a subscriber location, where a segment of the local loop includes a copper twisted pair carrying ADSL (col. 3, lines 6-10), where the ADSL has several derived digital telephone lines (col. 1, lines 29-31), and the subscriber interface couples the ADSL to an analog telephone (fig. 1, item 30). The method comprises the steps of monitoring at the subscriber interface the content of at least one data packet and determining if

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the derived digital telephone line is in use based on the content of the data packet (col. 4, lines 43-48) and generating a line-in-use signal (col. 4, lines 50-54; note: ring signal).

21. Regarding claim 56, the method further comprises receiving an add-a-line signal generated by the subscriber interface (col. 5, lines 8-10) in response to an action of a user (col. 5, lines 2-8) and initiating a second derived digital telephone line in response to the add-a-line signal (col. 5, lines 12-14).

22. Regarding claim 59, the ADSL includes a data channel for carrying data signals not related to the derived digital telephone lines (col. 2, lines 56-66; col. 3, lines 10-12).

23. Regarding claim 60, Whittaker discloses a method for use in a telecommunication system (fig. 1, item 16; fig. 2; col. 3, lines 17-25) including a digital switch (fig. 2, item 92), a local loop (fig. 1, item 12) coupling the digital switch to a subscriber location, where a segment of the local loop includes a copper twisted pair carrying ADSL (col. 3, lines 6-10), where the ADSL has several derived digital telephone lines (col. 1, lines 29-31), and the subscriber interface couples the ADSL to an analog telephone (fig. 1, item 30). The method comprises the steps of receiving an off-hook signal (col. 5, lines 7-8), generated by the subscriber interface in response to a user action (col. 5, lines 3-8) and initiating a first derived digital telephone line in response to the off-hook signal (col. 5, lines 9-14).

24. Regarding claim 61, a line-in-use signal, generated by the subscriber interface indicates that a first derived digital telephone line is in use (col. 5, lines 5-8).

25. Regarding claim 63, the contents of data packets are monitored at the subscriber interface (col. 4, lines 43-50).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 48 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whittaker et al. (US 6,130,893) in view of Johnson (US 5,999,801).

26. Regarding claim 48, Whittaker discloses a subscriber interface (fig. 1, item 20; fig. 31 col. 3, lines 31-35) for use in a telecommunications system (fig. 1, item 16; fig. 2; col. 3, lines 17-25) including a digital switch (fig. 2, item 92), a local loop (fig. 1, item 12) coupling the digital switch to a subscriber location, where a segment of the local loop includes a copper twisted pair carrying ADSL (col. 3, lines 6-10), where the ADSL has several derived digital telephone lines (col. 1, lines 29-31), and the subscriber interface couples the ADSL to an analog telephone (fig. 1, item 30). The subscriber interface comprises an inherent housing (fig. 3), an electric coupler for connection to a cable carrying the ADSL (item 47; col. 3, lines 10-11; note: the jack 47 is

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connected to the LAN which is connected to the ADSL modem), an RJ-11 jack (item 48; col. 4, lines 53-54), and a converter (fig. 3, items 58 and 66) coupled to the electrical coupler and RJ-1 jack, for converting the first analog signals generated by the analog telephone into a first plurality of data packets for transmission to a selected one of the derived digital telephone lines (col. 1, lines 29-31; col. 5, lines 5-15) and for converting a second plurality of data packets received from the selected one of the derived digital telephone lines into a second analog signal for transmission to the analog phone (col. 4, lines 43-55 and line 60 through col. 5, line 2).

27. However, Whittaker does not disclose that the housing has a top surface and a bottom surface that are substantially coplanar. Johnson discloses an electrical device having a housing with co-planar top and bottom surfaces (fig. 1, item 10). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to have co-planar top and bottom surfaces for the subscriber interface in the invention of Whittaker in order to provide a simple box design for construction and manufacturing.

28. Regarding claim 53, in Whittaker the ADSL includes a data channel for carrying data signals not related to the derived digital telephone lines (col. 2, lines 56-66; col. 3, lines 10-12).

Claims 49-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whittaker and Johnson as applied to claim 48 above, and further in view of Yuen (US 4,351,125).

29. Regarding claims 49-50, Whittaker in view of Johnson does not disclose a housing having an indented portion for accepting an analog telephone, where the width of the housing is greater than the height. Yuen discloses an indented portion of a housing for accepting a telephone (fig. 1, item 4; col. 2, lines 38-45). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to have an indented portion in a top surface

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for accepting a telephone in the invention of Whittaker in view of Johnson to denote the proper place for a user to rest the telephone.

30. Further, Whittaker in view of Johnson does not specifically disclose that the housing width is greater than the height. Yuen discloses that a telephone stand has a width greater than its height (fig. 1). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to have a housing for accepting a telephone having a width greater than its height in the invention of Whittaker in view of Johnson in order to provide a stable support for the telephone.

31. Regarding claim 52, in Whittaker the analog telephone in combination with the subscriber interface is capable of accessing and monitoring several derived digital telephone lines (col. 4, lines 43-48 and 60-62) and selecting a derived digital telephone line for conducting a call (col. 5, lines 3-15). A third plurality of data packets is converted to a third received signal for transmission to the analog telephone (col. 4, lines 43-49; note: packets coming from various sources are destined to the subscriber interface -- col. 4, lines 10-14).

Claim 51 is rejected under 35 U.S.C. 103(a) as being unpatentable over Whittaker and Johnson in view of Yuen as applied to claim 48 above, and further in view of Harting et al. (US 6,130,944).

32. Whittaker in view of Johnson and Yuen does not disclose a bottom surface of the housing having non-skid feet. Harting discloses a bottom surface of a telephone device having non-skid feet (col. 2, lines 1-3). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to have non-skid feet on the bottom surface of the housing in the

invention of Whittaker in view of Johnson and Yuen in order to resist the movement of the housing.

Claims 55 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whittaker et al. (US 6,130,893) in view of Grabowy (US 4,588,862).

33. Regarding claim 55 and 62, Whittaker discloses a subscriber interface for providing a line-in-use signal (col. 4, lines 50-54 or col. 5, lines 5-8; note: ring signal or analog signal, respectively). However, Whittaker does not disclose providing a visual indicator at the subscriber interface in response to the line-in-use signal. Grabowy discloses providing a visual indicator in response to a line-in-use signal (col. 4, lines 42-50). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to have a visual indicator for a line-in-use condition at the subscriber interface in the invention of Whittaker in order to notify a user that a call is in place.

Claims 57-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whittaker et al. (US 6,130,893) in view of Fraser (US 5,926,464).

34. Regarding claims 57-58, Whittaker discloses a monitoring derived digital telephone lines (col. 4, lines 43-48). However, Whittaker does not disclose receiving a hold signal, generated by the subscriber interface in response to an action and placing the second derived digital telephone line on hold in response to the hold signal, or receiving a line signal indicating a derived digital telephone line and accessing the corresponding derived digital telephone line. Fraser discloses a packet based telephony system (fig. 2) allowing call waiting (col. 1, line 62 through col. 2, line 7; col. 14, lines 51-58). The selecting is achieved by generating signaling at the subscriber interface (fig. 1, item 10) to select the appropriate telephone call (col. 14, lines 58-59; note: switch hook

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flash -- col. 5, lines 8-11). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to have a call waiting feature in the invention of Whittaker in order to allow a user to conveniently receive multiple telephone calls in a packet-based network.

35. Regarding claim 64, Whittaker discloses providing signaling at a subscriber unit.

However, Whittaker does not disclose generating an on-hook signal. Fraser discloses generating an on-hook signal (col. 9, lines 39-46; col. 5, lines 8-11) at a subscriber interface of a packet network (fig. 2) and terminating the derived digital telephone line in response to the on-hook signal. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to generate an on-hook signal in the subscriber interface of Whittaker in order to communicate a user's desire to end a call.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Harper whose telephone number is 571-272-3166. The examiner can normally be reached weekdays from 11:30 AM to 7:00 PM ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema S. Rao, can be reached at 571-272-3174. The centralized fax number for the Patent Office is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications associated with a customer number is available through Private PAIR only. For more information about the PAIR system, see portal.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kevin C. Harper

March 20, 2005

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